

REMARKS:

Claims 29-54 are currently pending in the application.

Claims 1-28 have been canceled without *prejudice*.

Claims 29, 30, 32-38, 40-46, and 48-54 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. (“*Haji*”) in view of U.S. Patent No. 6,260,024 to Shkedy (“*Shkedy*”) and in further view of U.S. Patent No. 6,105,004 to Halperin et al. (“*Halperin*”).

Claims 31, 39, and 47 stand rejected under 35 U.S.C. § 103(a) over *Haji* in view of *Shkedy* and *Halperin* and in further view of Official Notice and U.S. Publication No. 2001/0032878 A1 to Tsiounis et al. (“*Tsiounis*”).

Applicant respectfully submits that all of Applicant’s arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 29, 30, 32-38, 40-46, and 48-54 stand rejected under 35 U.S.C. § 103(a) over *Haji* in view of *Shkedy* and in further view of *Halperin*. Claims 31, 39, and 47 stand rejected under 35 U.S.C. § 103(a) over *Haji* in view of *Shkedy* and *Halperin* and in further view of Official Notice.

Applicant respectfully submits that the *amendments to Claim 30 has rendered moot the Examiner’s rejection of these claims and the Examiner’s arguments in support of the rejection of these claims*. Applicants further respectfully submit that amended Claim 30 in its current form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Haji*,

Shkedy, Halperin, or the Examiner's Official Notice, either individually or in combination. Thus, Applicant respectfully traverses the Examiner's obvious rejection of Applicant's Claims under 35 U.S.C. § 103(a) over the proposed combination of *Haji, Shkedy, Halperin*, or the Examiner's Official Notice, either individually or in combination.

The Proposed *Haji-Shkedy-Halperin* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to Claim 30, this claim recites:

A system for locally generating price quotes, the system comprising:
a plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server, each server configured to:
 receive one or more pricing tools from one or more of the plurality of sellers, the one or more pricing tools configured to generate one or more price quotes for one or more corresponding plurality of sellers;
 locally store the one or more pricing tools received from one or more of the plurality of sellers in the database coupled with each of the plurality of buyer computers, such that the one or more pricing tools are locally accessible to the server coupled with each of the plurality of buyer computers;
 access a request for quote (RFQ) specifying an order comprising quantities of one or more items, the RFQ requesting a price quote for the order;
 communicate the RFQ to the locally accessible one or more pricing tools stored in the database;
 using the locally accessible one or more pricing tools received from one or more of the plurality of sellers, locally generate, at the corresponding buyer computer, one or more price quotes for the order; and
 provide the locally generated one or more price quotes for the order for possible further action by the corresponding buyer computer.

(Emphasis Added). In addition, *Haji, Shkedy, or Halperin*, either individually or in combination, fail to disclose each and every limitation of Claims 29, 38, 46, and 54.

The Office Action Acknowledges that *Haji* Fails to Disclose Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Haji* fails to disclose various limitations recited in Claim 30. In essence, the Examiner appears to acknowledge that *Haji* fails to teach a "*plurality of buyer computers coupled with a plurality of*

sellers via a network, each of the plurality of buyer computers comprising a database and a server," as required in Claim 30 as amended. (29 January 2009 Final Office Action, page 4). However, the Examiner asserts that the cited portions of *Shkedy* disclose the acknowledged shortcomings in *Haji*. Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Shkedy*.

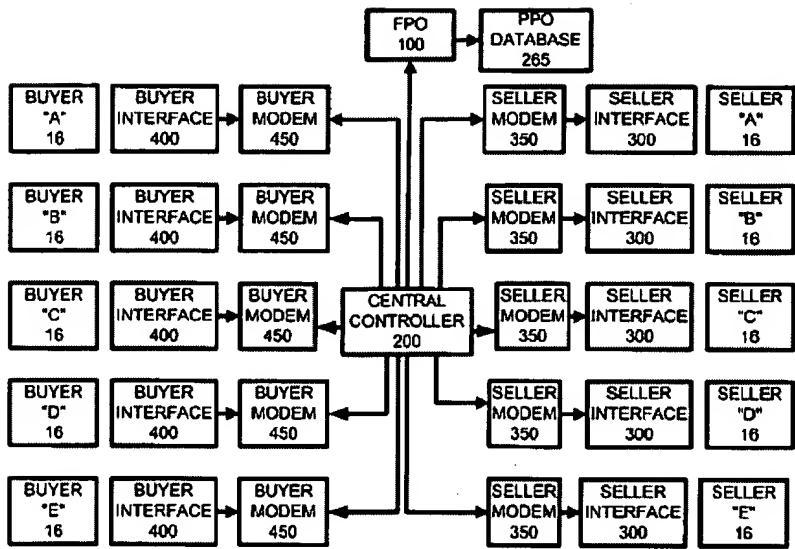
In particular, the Examiner states:

Shkedy teaches this matter (Figs. 1-2).

(29 January 2009 Final Office Action, page 4). (Emphasis added). By contrast the cited portion of *Shkedy* on which the Examiner relies does not teach a "*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server,*" as recited in Claim 30 as amended, but rather *Shkedy* merely describes a system that requires an "*intermediary*." For example, Applicant respectfully directs the Examiner's attention to *Shkedy* "Field of the Invention" section:

The method and apparatus of the present invention relates to electronic commerce network applications and, more particularly, to a system and method for *facilitating a transaction* between a plurality of buyers, *an intermediary*, and a plurality of sellers over an electronic network.

(Column 1, lines 8-12.) (Emphasis added). As clearly shown above, *Shkedy* makes clear that *Shkedy* merely facilitates a "transaction between a plurality of buyers, *an intermediary*, and a plurality of sellers over an electronic network." (Column 1, lines 8-12.) (Emphasis added). Applicants respectfully submit that merely "*facilitating a transaction* between a plurality of buyers, *an intermediary*, and a plurality of sellers over an electronic network" does not equate to a "*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server,*" as required in Claim 30. That is the "*intermediary*" as disclosed in *Shkedy*, does not equate to the "*network*," as required in Claim 30 because, as discussed above, *merely facilitates* a "transaction between a plurality of buyers, *an intermediary*, and a plurality of sellers over an electronic network. In fact, Applicant respectfully directs the Examiner's attention to Figure 1, on which the Examiner relies:



Applicant respectfully submits that the Examiner has mischaracterized Figure 1 and the cited portion of *Shkedy*. In fact, Applicant finds no such teachings anywhere in *Shkedy* of a “*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server*” and certainly not in the portion of *Shkedy*, cited by the Examiner. For example, Applicant respectfully directs the Examiner’s attention to the cited portion of *Shkedy*, on which the Examiner relies:

FIG. 1 illustrates a plurality of buyers electronically coupled to *central controller [intermediary] 200* with buyer modems 450, the *central controller [intermediary] 200* is electronically coupled to a plurality of seller [sic] through seller modems 350 and sellers 300. Each of the plurality of buyers who wish to make purchases *independently access the central controller [intermediary] 200* to create forward purchase orders (FPOs) to submit their purchase orders for items and/or services. The *central controller [intermediary] 200* is preferably located at a remote server.

(Column 4, line 65 through column 5, line 6). (Emphasis added). As clearly shown in Figure 1 of *Shkedy* and the cited portions of *Shkedy*, *Shkedy* does not teach, suggest, or even hint at a “*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server*,” as required by Claim 30 as amended, but merely “illustrates a plurality of buyers electronically coupled to *central controller [intermediary] 200* with buyer modems 450, the *central controller [intermediary] 200* is electronically coupled to a plurality

of seller [sic] through seller modems 350 and sellers 300.” (Column 4, line 65 through column 5, line 2). (Emphasis Added).

At most, *Shkedy* merely teaches that a “*central controller [intermediary] 200*” is coupled to a plurality of buyer modems and a plurality of seller modems. (Column 4, line 65 through column 5, line 6 and Figure 1). (Emphasis Added). Therefore, the cited portions of *Shkedy* on which the Examiner relies, clearly does not disclose a “*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server*” or even any type of network, but rather merely discloses that a “*central controller [intermediary] 200*” is coupled with a plurality of buyer modems and a plurality of seller modems, or put another way, the system as disclosed in *Shkedy* clearly does not equate to a “*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server*,” as required by Claim 30 as amended.

Thus, *Shkedy* cannot provide for a “*plurality of buyer computers coupled with a plurality of sellers via a network*” or even “*each of the plurality of buyer computers comprising a database and a server*,” since *Shkedy* fails to disclose *network* as recited in Claim 30, in the first place. In addition, Applicants respectfully request clarification from the Examiner as to how “*Shkedy teaches this matter (Figs. 1-2)*,” as asserted by the Examiner.

In addition, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to *allow buyers and sellers in Haji's teaching to be coupled to a network and the buyers information are stored in a database for better centralize transactions*.

(29 January 2009 Final Office Action, page 4). (Emphasis added). Applicant respectfully disagrees and respectfully submits that Applicant finds no such teachings anywhere in *Shkedy* and certainly not in the cited portions of *Shkedy*, relied upon by the Examiner. In fact, as noted above, the Examiner merely states:

Shkedy teaches this matter (Figs. 1-2).

(29 January 2009 Final Office Action, page 4). (Emphasis added). However, Applicant respectfully directs the Examiner's attention to Figure 2, on which the Examiner relies:

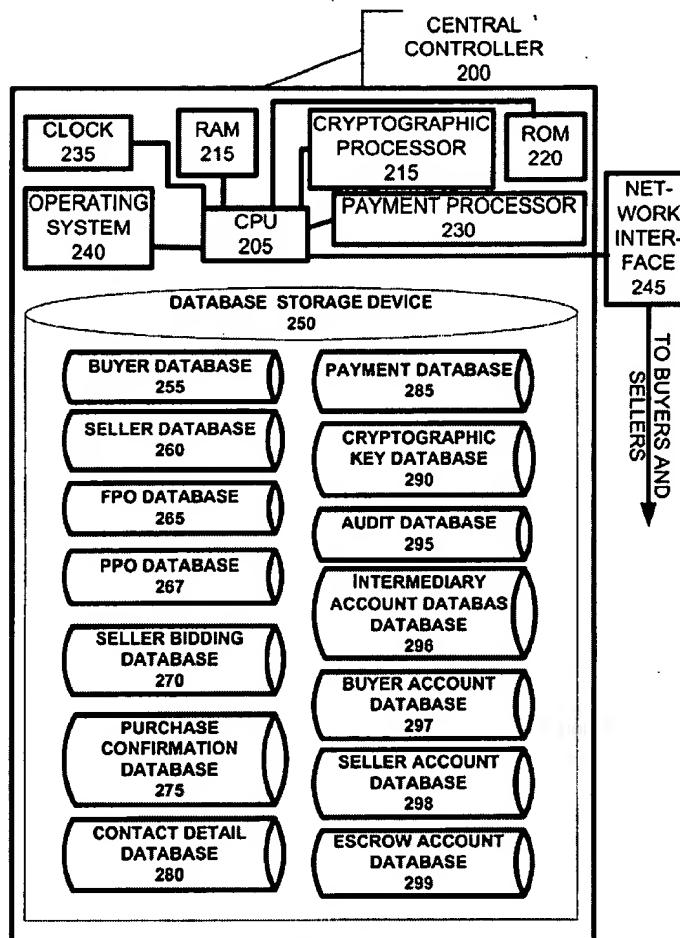
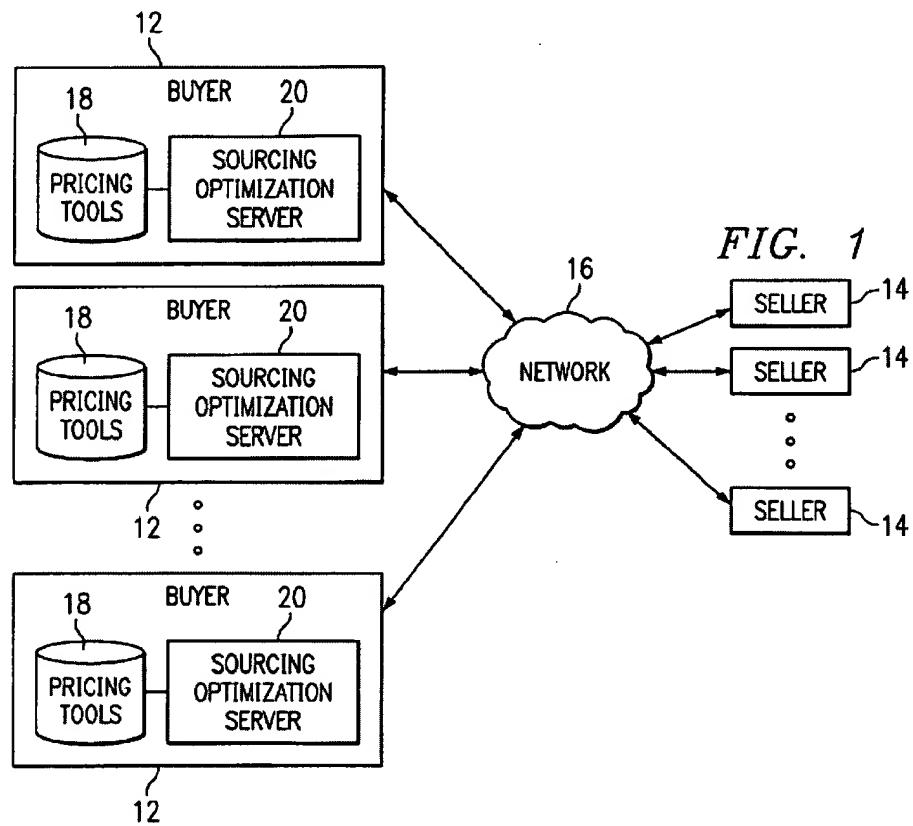


FIG. 2

Applicant respectfully submits that the Examiner has mischaracterized Figure 2 and the cited portion of *Shkedy*. As clearly shown in Figure 2 of *Shkedy*, *Shkedy actually teaches away from Claim 30* as amended. For example, Figure 2 of *Shkedy* does not teach a “*plurality of buyer computers coupled with a plurality of sellers via a network, each of the plurality of buyer computers comprising a database and a server*,” as required by Claim 30 as amended, but rather merely shows a *single “database storage device 250” associated only with the “central controller [intermediary] 200”* of Figure 1 which *Shkedy* teaches *is preferably located at a remote server*. (Column 4, line 65 through column 5, line 6 and column 9, lines 54-67). (Emphasis added).

Applicants respectfully submit that the “*central controller [intermediary] 200*” of *Shkedy* cannot be both the “*network*” as recited in Claim 30 and the “*plurality of buyer computers*” as also recited in Claim 30. In fact, Figure 2 of *Shkedy* is merely a block diagram showing “*central controller [intermediary] 200*” of Figure 1 of *Shkedy*, which as discussed above, is *not* a “*plurality of buyer computers*” as recited in Claim 30 or even a buyer, but rather is merely an “*intermediary*.” (Column 9, lines 54-67). (Emphasis added). The difference can be clearly seen with reference to Figure 1 of the subject application, shown below:



In addition, as discussed above, the Examiner appears to equate the “*database*” recited in independent Claim 30 with the “*database storage device 250*” disclosed in *Shkedy*. (29 January 2009 Final Office Action, page 4). Applicant respectfully submits that this equation is inaccurate, that is the “*database storage device 250*” as disclosed in *Shkedy*, does not equate to the “*database*,” as recited in Claim 30 as amended because, among other things, the “*database storage device 250*” of *Shkedy* is part of the “*central controller [intermediary] 200*” of Figure 1 and not “*each of the plurality of buyer computers*,” as required in Claim 30.

In addition, *Shkedy* makes clear that the seller of *Shkedy* is merely dealing with the “*intermediary*” of *Shkedy* and *not with the buyer* of *Shkedy*. For example, Applicant respectfully directs the examiner’s attention to *Shkedy*:

The seller has now entered into a legally binding contract with the intermediary.

(Column 6, lines 27-28). As clearly shown in the cited portion of *Shkedy*, *Shkedy* provides for the seller to enter into a contract with the “*intermediary*,” and not the buyer of *Shkedy*. Thus, *Shkedy* cannot provide for a “*plurality of buyer computers coupled with a plurality of sellers via a network*” or even “*each of the plurality of buyer computers comprising a database and a server*,” since *Shkedy* fails to disclose *network* as recited in Claim 30, in the first place. In addition, Applicants respectfully request clarification from the Examiner as to how “*Shkedy teaches this matter (Figs. 1-2)*,” as asserted by the Examiner.

In addition, the Examiner states:

... to allow buyers and sellers in Haji's teaching to be coupled to a network and the buyers information are stored in a database for better centralize transaction.

(29 January 2009 Final Office Action, page 4). (Emphasis added). Applicant respectfully directs the Examiner’s attention to Claim 30 which recites, *inter alia*, a *plurality of buyer computers comprising a server configured to “locally store the one or more pricing tools received from one or more of the plurality of sellers in the database [associated with each of the plurality of buyer computers]*, such that the one or more pricing tools are locally accessible to the server” *associated with each of the plurality of buyer computers* and not “*the buyers information are stored in a database for better centralize transaction*,” as asserted by the Examiner. (29 January 2009 Final Office Action, page 4). (Emphasis added). Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Shkedy* and Claim 30 as amended cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish Claim 30 from *Shkedy*.

The Office Action Acknowledges that the proposed *Haji-Shkedy* Combination Fails to Disclose Various Limitations Recited in Applicant’s Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that the proposed combination of *Haji* and *Shkedy* fails to disclose various limitations recited in Claim 30. Specifically the Examiner acknowledges that the proposed combination of *Haji* and *Shkedy* fails to teach “the specified order comprising *quantities of one or more items*.” (29 January 2009 Final Office Action, page 4). However, the Examiner asserts that the cited portions of *Halperin* disclose the acknowledged shortcomings in *Haji* and *Shkedy*. Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Halperin*.

Applicant respectfully submits that *Halperin* fails to disclose Claim 30 elements regarding a *plurality of seller computers comprising a server configured to “accesses a request for quote (RFQ) specifying an order comprising quantities of one or more items*, the RFQ requesting a price quote for the order”. In particular, the Examiner equates “*quantities of one or more items*” recited in Claim 30 with the “*purchase information*” disclosed in *Halperin*. (29 January 2009 Final Office Action, page 4). However, the “*purchase information*” disclosed in *Halperin* is merely displayed on a screen, but *does not include, involve, or even relate to the quantities of one or more items*, as required by Claim 30. (Column 4, Lines 1-4). In contrast, the “*quantities of one or more items*” required by Claim 30 *is associated with a buyer for locally generating price quotes wherein a request for quote is accessed specifying an order which comprises quantities of one or more items*. Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Halperin* and Claim 30 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish Claim 30 from *Halperin*.

The Proposed *Haji-Shkedy-Halperin-Official-Notice-Tsiounis* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant’s Dependent Claims 31, 39, and 47

For example, with respect to dependent Claim 31, this claim recites:

The system of Claim 30, wherein the *one or more pricing tools are encrypted* to prevent the one or more pricing tools from being used to determine how price quotes are calculated. (Emphasis Added).

In addition, *Haji*, *Shkedy*, *Halperin*, or the Examiner's Official Notice, either individually or in combination, fail to disclose each and every limitation of dependent claims 39 and 47.

The Office Action Acknowledges that the proposed *Haji-Shkedy-Halperin* Combination Fails to Disclose Various Limitations Recited in Applicant's Dependent Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that the proposed combination of *Haji*, *Shkedy*, and *Halperin* fails to disclose various limitations recited in dependent Claim 31. Specifically the Examiner acknowledges that the proposed combination of *Haji*, *Shkedy*, and *Halperin* fails to teach "the pricing tools are encrypted to prevent the pricing tool from being used to determine how price quotes are calculated". (29 January 2009 Final Office Action, page 6). However, the Examiner asserts Official Notice over the acknowledged shortcomings in *Haji* and *Shkedy*. Applicant respectfully traverses the Examiner's Official Notice.

The Examiner's *Official-Notice* is improper under MPEP § 2144.03

Applicant respectfully submits that Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. *Applicant respectfully traverses the Official Notice because the asserted facts*, as best understood by Applicant, *are not supported by substantial documentary evidence or any type of documentary evidence* and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). *Applicant respectfully requests the Examiner to produce authority for the Examiners Official Notice.*

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence *should only be taken by the examiner* where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*.

With respect to the subject Application, the Examiner's statement that the "Examiner takes Official Notice that encrypting information for preventing unauthorized parties from revealing the information is old and well known in the art," *is not capable of instant and unquestionable demonstration as being well-known*. (29 January 2009 Final Office Action, page 6). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '*capable of such instant and unquestionable demonstration as to defy the dispute*' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is *never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record*, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that *general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection*). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. Applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject application, the Examiner alleges:

Tsiounis teaches encrypting information and data encryptions are well known in the art (¶ 17, 40). Therefore, it would have been obvious to one of ordinary skill in the art to allow the pricing tools in the teachings of Haji modified by

Shkedy and Halperin to be encrypted for better protecting the information associated with the pricing tools.

(29 January 2009 Final Office Action, page 6). By contrast, the cited portion of *Tsiounis* on which the Examiner relies does not disclose that “the *one or more pricing tools are encrypted* to prevent the one or more pricing tools from being used to determine how price quotes are calculated,” as recited in dependent Claim 31, but rather *Tsiounis* merely states that “*credit card information is sent encrypted between the user and the merchant and is verified at the clearing house*”. (¶ 17). (Emphasis added). In fact, Applicant respectfully directs the Examiner’s attention to the cited portions of *Tsiounis* on which the Examiner relies:

Secure Electronic Transactions is a system designed by MasterCard and Visa to allow secure credit card transactions over the Internet. The system requires credit card clearing houses, merchants and *users to download and install the appropriate software*. The *credit card information is sent encrypted between the user and the merchant and is verified at the clearing house*, without exposing it to other users of the Internet or to the merchant himself. Digital signatures authenticate each transaction for future auditing.

(¶ 17). (Emphasis added). Therefore, *Tsiounis* fails to provide documentary evidence to support the Official Notice taken by the Examiner, that is, “Examiner takes Official Notice that encrypting information for preventing unauthorized parties from revealing the information is old and well known in the art” because it is simply not capable of “instant and unquestionable” demonstration as being well-known. (29 January 2009 Final Office Action, page 6). Applicant further respectfully submits that Applicant has adequately traversed the Examiners assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Applicant's Claims based on the Official Notice, Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Haji-Shkedy-Halperin*-Official-Notice Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Haji*, *Shkedy*, *Halperin*, or the Examiner's Official Notice, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*." (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, "While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls." (*KSR*, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “*ensure that the written record includes findings of fact* concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Haji, Shkedy, Halperin*, and the Examiner’s Official Notice. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made” to “allow buyers and sellers in Haji’s teaching to be coupled to a network and the buyers’ information are stored in a database” and “allow the specified order in the teaching of Haji modified by Shkedy to include quantities of the ordered items as taught by Halperin.” (29 January 2009 Final Office Action, page 4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Haji, Shkedy, Halperin*, and the Examiner’s Official Notice.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72

Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill*.

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Haji, Shkedy, Halperin, the Examiner's Official Notice and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.* The Office Action merely states that "for better centralize transactions" and "so that the buyer can have better idea of the total costs of the order that have multiple purchased items." (29 January 2009 Final Office Action, page 4). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Haji, Shkedy, Halperin, the Examiner's Official Notice and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.* Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (KSR, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Haji, Shkedy, Halperin, and the Examiner’s Official Notice to render obvious Applicant’s claimed invention*. The Examiner’s unsupported conclusory statements that “it would have been obvious to one of ordinary skill in the art at the time the invention was made” to “allow buyers and sellers in Haji’s teaching to be coupled to a network and the buyers’ information are stored in a database” and “allow the specified order in the teaching of Haji modified by Shkedy to include quantities of the ordered items as taught by Halperin” and “for better centralize transactions” and “so that the buyer can have better idea of the total costs of the order that have multiple purchased items”, *does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. (29 January 2009 Final Office Action, page 4). Applicant respectfully disagrees. For example, how does “*better protecting the information*” prevent the one or more pricing tools from being used to determine how price quotes are calculated and to what extent does the Examiner purport that “*better protecting the information*” applies to the subject

Application. In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Haji*, *Shkedy*, *Halperin*, and the Examiner's Official Notice, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.*

Applicant's Claims are Patentable over the Proposed *Haji-Shkedy-Halperin-Official-Notice* Combination

Claims 29, 30, 38, 46, and 54 are considered patentably distinguishable over the proposed combination of *Haji*, *Shkedy*, and *Halperin*.

Furthermore, with respect to dependent Claims 31-37, 39-45, and 47-53: Claims 31-37 depend from Claim 30; Claims 39-45 depend from Claim 38; and Claims 47-53 depend from Claim 46. As mentioned above, each of Claims 30, 38, and 46 are considered distinguishable over *Haji*, *Shkedy*, or *Halperin*. Thus, dependent Claims 31-37, 39-45, and 47-53 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 29-54 are not rendered obvious by the proposed combination of *Haji*, *Shkedy*, *Halperin*, and the Examiner's Official Notice. Applicant further respectfully submits that Claims 29-54 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Applicant's Claims under 35 U.S.C. § 103(a) be reconsidered and that Claims 29-54 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee, to Deposit Account No. 500777.** Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

29 April 2009
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

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